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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,373	01/12/2005	Timothy Bateman	0119/0036	4686

21395 7590 09/29/2005

LOUIS WOO  
LAW OFFICE OF LOUIS WOO  
717 NORTH FAYETTE STREET  
ALEXANDRIA, VA 22314

EXAMINER

PATEL, MITAL B

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,373	<b>Applicant(s)</b> BATEMAN ET AL.	
	<b>Examiner</b> Mital B. Patel	<b>Art Unit</b> 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 14 and 15 is/are allowed.  
 6) ☒ Claim(s) 1,3,4,8-10,12 and 13 is/are rejected.  
 7) ☒ Claim(s) 5-7 and 11 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Response to Amendment/Arguments*

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 101*

2. Claims 10 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10 and 12 improperly positively claim a part of the human body. The Examiner suggests the following language for both claims, --an adhesive extending around its edge **adapted to** contact the user's skin.--

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nesti (US 4,807,617).
5. **As to claim 1**, Nesti teaches a mask apparatus including a generally ring shape sealing assembly **12** adapted to be retained with the head and to seal around at least a

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mouth of a user, and a gas inlet **26** for supplying gas to the apparatus, characterized in that the sealing assembly has a central opening **26** located in the region of the mouth and extending across the width of the mouth, and a removable closure **40** in the form of a transparent window secured in the opening to extend across the width of the mouth, and that the gas inlet is mounted with the window.

6. **As to claim 2**, Nesti teaches a mask apparatus characterized in that the closure window is curved and rigid.

7. **As to claim 4**, Nesti teaches a mask apparatus characterized in that the closure is a push fit in the central opening (**See Fig. 3**).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 8, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesti (US 4,807,617).

12. **As to claims 8 and 9**, Nesti teaches essentially all of the limitations except for a harness with the particulars as cited. The use of a harness for securing a mask to the wearer is well known in the respiratory art. As such, it would have been obvious to one of ordinary skill in the art to provide such a harness for the purposes of securely fitting a mask to the user.

13. **As to claim 13**, Nesti teaches essentially all of the limitations except for wherein the gas inlet is located to one side of the window. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make to provide the gas inlet at a different location because Applicant has not disclosed that a gas inlet located to one side provides an advantage, is used for a particular purpose, solves a stated problem, or provides unexpected results over that of any other shape. One of ordinary skill in the art, furthermore, would have expected Nesti's gas inlet, and applicant's invention, to perform equally well with the inlet as taught by Nesti or the claimed inlet because both inlets would perform the same

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function of letting gas in. Therefore, it would have been prima facie obvious to modify Nesti to obtain the invention as specified in claim 13 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Nesti.

14. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesti (US 4,807,617) in view of Kaimer (US 5,143,061).

15. **As to claims 10 and 12**, Nesti teaches essentially all of the limitations except for wherein the sealing assembly includes an adhesive extending around its edge to contact the user's skin. However, Kaimer does teach the use of an adhesive on a sealing assembly for a mask to provide a supplemental seal to prevent leakage of a gas. Therefore, it would have been obvious to one of ordinary skill in the art to provide adhesive on the sealing assembly edge so that a supplemental seal is provided to prevent leakage of a gas that is supplied to the user.

***Allowable Subject Matter***

16. Claims 5, 6, 7, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claims 14 and 15 are allowed over the prior art of record.

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4989598, US 4794921, US 4770169, and US 4449526.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 571-272-4802. The examiner can normally be reached on Monday-Friday (11:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mital B. Patel  
Primary Examiner  
Art Unit 3743